



Docket No.: SOA-0387
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Ellen Glassman et al.

Application No.: 10/815,016

Confirmation No.: 9225

Filed: March 31, 2004

Art Unit: 2621

For: METHOD AND APPARATUSES FOR
DISPLAYING CONTENT THROUGH A
STORAGE DEVICE

Examiner: NIGAR CHOWDHURY

REQUEST FOR PRE-APPEAL BRIEF PANEL REVIEW OF FINAL REJECTION

MS AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This is a full and timely response to the Final Office Action mailed on April 12, 2007.

The rejections found within the Final Office Action are traversed at least for the following reasons:

Claims 1, 3, 4, 7-13, and 22-33 are present within the above-identified application, with claims 1, 24, and 31 being independent claims.

Page 2 includes a rejection of claims 1, 3, 4, 7-10, 12, and 22-33 under 35 U.S.C. § 103(a) in view of U.S. Patent. No. 6,757,479 to Niikawa ("Niikawa") in view of U.S. Patent No. 6,329,787 to Ito et al. ("Ito").

Niikawa - Niikawa arguably discloses an image display device for browsing through image files located on a separate portable memory device. Figure 2 of Niikawa illustrates a conventional portable memory device 8 (e.g., a flash drive, floppy disk, etc.) and a magneto-optic disc 14, both lacking any attached display capabilities. The conventional portable memory

device 8 and magneto-optic disc 14, may be inserted into a reading interfaces 9 and 13, respectively, which thereby allow the information on these memory devices to be viewed on display device 1. While Niikawa includes a display device 1, this display device is separate and not a part of the portable memory device 8 and magneto-optic disc 14.

Ito - Ito arguably discloses a portable digital media viewing device for viewing pictures, images, sounds, video, etc. (column 5, lines 25-30). Figure 1 of Ito illustrates a portable device 14 having a display 12 and controls 32. A battery-charging device 24 charges portable device 14. Charging device 24 connects to a power source 50 and a data source 44 (or 147, in figure 5). Figure 3 of Ito illustrates the charging process for portable device 14. Prior to mounting portable device 14 onto charging device 24, a user selects the content that charging device 24 will provide portable device 14 (step 2; column 6, lines 51-56). This selection may be made via controls mounted on charging device 24 or by pre-setting the desired media information in portable device 14 (column 6, lines 51-56). After mounting portable device 14 onto charging device 24, charging device 24 serves the dual purpose of charging (step S4) and providing digital content for *transfer to and storage on* portable device 14 (steps S8-S9).

Ito does not disclose or suggest any device for specifically controlling *a recorder device*, and Ito does not suggest displaying functional controls on the display while the portable viewer is docked to the charger.

With respect to claim 22, neither Niikawa nor Ito disclose or suggest both “*displaying the image on the portable memory device while the portable memory device is detached from the recorder/playback device*” as recited in claim 1 (on which claim 22 depends), and “*wherein the portable memory device displays functional controls for the recorder/playback device while the portable memory device is connected to the recorder/playback device*” as recited in claim 22.

Page 3 of the Final Office Action admits that Niikawa does not disclose or suggest “*displaying the image on the portable memory device while the portable memory device is detached from the recorder/playback device*”. Niikawa only discloses conventional portable memory devices, lacking any attached display capabilities (*e.g.*, a flash drive, floppy disk, etc.).

Ito merely discloses selecting content to load from a remote data source. Ito does not disclose that a portable memory device displays functional controls on the portable display for controlling a separate recorder/playback device.

Neither, Niikawa nor Ito teach a portable memory device that does anything more than store or display content. The distinct differences between the devices disclosed in Niikawa (*i.e.*, a multi-component image capture and editing workstation) and Ito (*i.e.*, a portable digital media device) would not prompt one of ordinary skill to create a portable memory device that displays images while detached from the recorder, and displays functional control information for controlling a multi-component recorder/playback device system while the memory device is connected to the recorder.

While Ito mentions pre-setting the desired type of content to load into a portable media device, Ito offers no disclosure of or support for modifying Niikawa to create a portable memory device that functions as part of a user interface for a recording device. Instead, a combination of Niikawa and Ito would only provide a memory device, attachable to an image editing system, capable of displaying images stored thereon. Accordingly, a combination of the relied upon references would fail to yield the claimed invention

For similar reasons, claims 25 and 32 are also neither disclosed nor suggested by Niikawa and Ito, alone or in combination.

Furthermore with respect to claim 22, neither Niikawa nor Ito disclose or suggest “wherein said functional controls include **soft keys** that are **particular to the recorder/playback device.**”

Soft keys are a *term of art* referring to software driven controls. Soft Keys are multi-function state-based keys that use part of the display to identify their function at any moment. Such keys are usually positioned directly next to the display, making it simple to identify which portion of the display illustrates the functionality currently associated with a button. As the user interacts with the device, the portion of the display indicating the functionality of each button may change along with the actual functionality of the associated button.

Neither Niikawa nor Ito disclose or suggest the use of soft keys.

For similar reasons, claims 25 and 32 are also neither disclosed nor suggested by Niikawa and Ito, alone or in combination.

With respect to claim 23, neither Niikawa nor Ito disclose or suggest “*wherein the portable memory device is configured to include an attachment area, said attachment area including a magnet for attaching the portable memory device to a metallic object, such that the portable memory device displays the image while attached to the metallic object*”.

The Office Action *does not cite any portion of either Niikawa or Ito* as the basis for magnetically attaching a memory device. Instead, the Office Action takes “*official notice*” that using magnets to attach metallic devices is known. The Final Office Action fails to identify any examples, “known in the art,” where magnets are used to attach “portable memory devices” by anything beyond mere conjecture and conclusory statements.

“Official notice without documentary evidence to support an examiner’s conclusion is permissible only in some circumstances. While “official notice” may be relied on, these circumstances **should be rare when an application is under final rejection or action under 37 CFR 1.113**... As noted by the court in *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be “**capable of such instant and unquestionable demonstration as to defy dispute**” (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 USPQ 6 (CCPA 1961)).”
MPEP § 2144.03 (A)

The Office Action fails to provide any “known” prior art employing magnets to connect portable memory and display devices. On the contrary, the use of magnets to attach a memory device is not obvious due to the need to prevent damage to the memory device from the magnetic interference, as well the need to prevent damage to the delicate circuit in portable displays.

For similar reasons, claims 26 and 33 are also neither disclosed nor suggested by Niikawa and Ito, alone or in combination.

Claim 27 recites "*wherein the interface means connects to and detaches from the recorder/playback device via a wireless connection.*"

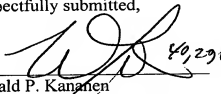
Neither Niikawa nor Ito disclose a wireless connection capable of supporting an interface to a recorder/playback device, which is ordinarily understood to be a radio-based connection. While the Ito device employs a cradle, a cradle is not a wireless connection as understood by one of ordinary skill.

Accordingly, withdrawal of the rejections pertaining to at least the above-mentioned claims is respectfully requested.

Applicant notes that the due date for this brief with a two-month extension is Thursday, July 12, 2007. Accordingly, this filing is timely as filed on July 12, 2007, with a two-month extension fee. If any further fee is required or any overpayment made, the Commissioner is hereby authorized to charge the fee or credit the overpayment to Deposit Account # 18-0013.

Dated: July 12, 2007

Respectfully submitted,

By  8/02/07

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